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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Graf et al.
Appl. No. : 09/623,115
Filed : December 19, 2000
Grp./A.U. : 1714
Examiner : Edward J. Cain

Confirmation No.: 7002

Docket No. : H 3301 PCT/US
Customer No.: 23657

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 27, 2004.

August 27, 2004
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 222313-1450


Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192. Please charge the required fee of \$330.00 to our Deposit Account No. 50-1177. This paper is enclosed in triplicate. Order No. 04-0408.

The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment to Deposit Account 50-1177.

Respectfully submitted,

Cognis Corporation
300 Brookside Avenue
Ambler, PA 19002


Steven J. Trzaska
(Reg. No. 36,296)
Attorney for Applicant(s)
(215) 628-1416



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BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Deutschland GmbH & Co. KG,
Henkelstrasse 67, 40589 Duesseldorf, Germany.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 14-20 are the subject of this appeal. Claims 21-30 have been allowed by the Examiner.

STATUS OF AMENDMENTS

No amendments were made after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a fiber-free molding composition containing: (a) a binder selected from the group consisting of an epoxide, a polyisocyanate, a furane- and resin-free phenolic resin and combinations thereof; (b) a filler mixture containing an inorganic high-temperature-resistant filler and a heat-activatable swelling agent. See page 3, lines 5-10.

ISSUES

Whether claims 14, 16, 18 and 20 are anticipated under 35 U.S.C. § 102(b) by Crompton (US 5,082,494).

GROUPING OF THE CLAIMS

The claims do not stand and fall together since the limitations contained in claims 15, 17 and 19 are admittedly patentable over the disclosure of the Crompton reference.

ARGUMENT

Crompton '494 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Appellant would first like to note that it is well settled in the law that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of a claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy,

17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). Appellant respectfully submits that the '494 reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

The Examiner has based his conclusion of anticipation on Crompton's disclosure regarding the possible use of a phenolic resin/curing system, at col. 3, lines 43-44. (See Paper No. 10, page 2). Neither of the other two binder candidates claimed by the present invention, i.e., an epoxide and a polyisocyanate, are disclosed by the Crompton reference. However, with respect to the phenolic resin binder disclosed by Crompton, upon careful analysis of this disclosure, it is seen that nowhere within the four corners of the Crompton reference is it disclosed, or even suggested, to employ a **furane-free** and **resin-free** phenolic resin binder. On the contrary, at col. 1, lines 56-58, Crompton clearly discloses that while phenolic resins, **in general**, may be used as a binder, it is **preferred** to use an adhesive such as sodium silicate instead. Consequently, rather than even suggesting that the claimed **furane-free**, and **resin-free** phenolic resin binder be employed in its product, Crompton motivates the routineer to forego phenolic resins altogether and employ sodium silicate instead.

In the Advisory Action dated July 15, 2004, at page 2, the Examiner takes the position that if the reference intended furane containing resins, it would have so stated. In response thereto, Appellant respectfully submits that a finding of anticipation cannot be based on what a reference does not disclose, but rather, on what it does disclose. In other words, Crompton's disclosure regarding the possible use of phenolic resin does not preclude the presence of furane and/or resin in the phenolic resin. Furane-containing phenolic resins are phenolic resins nevertheless, as are resin-containing phenolic resins. Moreover, whereas Appellant's claimed invention expressly precludes the presence of furane and resins within its phenolic resin, Crompton merely suggests that phenolic resins may be used, whether they contain furane and/or resin is apparently immaterial. Consequently, it is Appellant's position that since this reference fails to disclose the use of a **furane-free** and **resin-free** phenolic resin binder, it cannot serve to anticipate the claimed invention, per In re Levy, supra.


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SUMMARY

Crompton '494 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,



Steven J. Trzaska
(Reg. No. 36,296)
Attorney for Applicant(s)
(215) 628-1416

Cognis Corporation
300 Brookside Avenue
Ambler, PA 19002

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Enc.: Appendix

APPENDIX

CLAIMS ON APPEAL

14. A fiber-free molding composition comprising:
- (a) a binder selected from the group consisting of an epoxide, a polyisocyanate, a furane-resin-free phenolic resin, and mixtures thereof; and
 - (b) a filler mixture containing:
 - (i) from about 20 to 90% by weight, based on the weight of the filler mixture, of an inorganic high-temperature-resistant filler; and
 - (ii) a heat-activatable swelling agent.
15. The composition of claim 14 wherein the filler mixture further comprises:
- (iii) an adhesive;
 - (iv) a micropore-forming, high-temperature-resistant filler; and
 - (v) a grinding and/or anticaking agent.
16. The composition of claim 14 wherein the filler mixture has a pH of up to 7.5.
17. The composition of claim 15 wherein the filler mixture contains:
- (i) from 20 to 90% by weight of the inorganic high-temperature-resistant filler;
 - (ii) from 1 to 30% by weight of the heat-activatable swelling agent;
 - (iii) from 0.1 to 35% by weight of the adhesive;
 - (iv) from 2 to 40% by weight of the micropore-forming, high-temperature-

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resistant filler; and

(v) from 0.01 to 10% by weight of the grinding and/or anticaking agent, all weights being based on the total weight of the molding.

18. The composition of claim 14 further comprising a hardener.
19. The composition of claim 14 further comprising an emulsifier and a blowing agent.
20. The composition of claim 14 wherein the molding has a density of from 100 to 300 kg/m³.